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BAKER & DANIELS LLP
300 NORTH MERIDIAN STREET
SUITE 2700
INDIANAPOLIS, IN 46204

EXAMINER	
WATSON, ROBERT C	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/689,337
Filing Date: October 20, 2003
Appellant(s): HAYES, KENNETH O.

Thomas A. Ladd
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 8, 2006 appealing from the Office action mailed December 5, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,609,325	DeArmond	03-1997
4,368,874	Weisgerber	01-1983
4,472,986	Gottleib	09-1984

6,848,341 Pace et al 02-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 5, 7, 11-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeArmond in view of Weisgerber.

DeArmond teaches a tool having a body member, a blade, and an arcuate support. The arcuate support functions as a rocking fulcrum.

Weisgerber teaches that web 48 may substantially span a support 12 and a body 22. The Weisgerber support 12 has an arcuate portion. The Weisgerber support 12 functions as a rocking fulcrum.

To provide in DeArmond a web to substantially span the support and body would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Weisgerber. One of ordinary skill in the art would have been motivated to do this in order to strengthen the tool.

The phrase, "A web substantially spanning said arcuate support and said body along the length of said arcuate support" (claim 1, lines 5-6; ie., the last two lines of this 6 line independent claim) is so overly broad that this phrase may be interpreted in at least two quite different ways. Firstly, the word "substantially" can be reasonably interpreted as modifying the term "span". Secondly, and alternatively, the word "substantially" can also be reasonably interpreted as modifying the term "length" (along the arcuate support). Looking at the first interpretation, in Weisgerber the web 48 extends completely (not incompletely) from the body 22 to the support 12 and may

therefor be said to span 100% of the distance between the support and the body. A 100% span between the body 22 and the support 12 is certainly a substantial span. Note that Webster's New Collegiate Dictionary (1975) defines span as "an arch over...<something>" "eg., a small bridge spanned the pond". Clearly, the usual interpretation of the length of the span of a bridge would be the distance of the bridge in the direction across the pond and not the distance of the width of the bridge at its entrance or exit to the land. Similarly, the length of the span of the web 48 is the distance of the web between body 22 and support 12 and not the distance of the small width of web 48. This substantial span between body 22 and support 12 does extend a a very small distance along the length of the support (just as a bridge has a width at the entrance and exit to the land). **By this first interpretation, the portion of the web 48 along the length of the support 12 need not be substantial.** Looking at the second interpretation, where the distance of the web along the length of the support is substantial we are only raising the issue of an alleged size difference between the Weisgerber reference and the instant case. Court decisions have consistently held that size considerations are ordinarily of no patentable significance. The distance of the web along the body member is no more than an obvious matter of design choice absent a showing of criticality for this feature. Since the web (which is a brace or strut) is for strength one skilled in the art would have been motivated to increase the distance of the web along the body member to therefor increase the strength of the device. Also, court decisions have consistently held that merely reinforcing a device with struts, webs, braces, and gussets is obvious. **By this second interpretation, the portion of the**

web 48 along the length of the support 12 needs to be substantial but merely increasing the size of the distance of the web in Weisgerber along the length of the support so that this distance is substantial would have been obvious for one skilled in the art.

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeArmond in view of Wiesgerber supra and further in view of Gottlieb.

Gottlieb teaches that a hole 18, which may be termed a loop hanger, may be located on the very end of the handle of a tool for the purpose of hanging the tool on a hook or nail in a workshop. Webster's New Collegiate Dictionary (1975) defines a "loop" as a closed curve. In Gottleib hole 18 is closed curve. Since the Gottleib hole18 (closed curve 18) functions as a hanger this hole may properly be termed a "loop hanger".

To provide a loop hanger on the very end of the handle in the above applied structure of DeArmond in view of Wiesgerber surpa would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Gottlieb. One of ordinary skill in the art would have been motivated to do this in order to provide a convenient method of storing the tool when not in use; ie., hanging the tool on a peg by means of a loop hanger on very end of the tool handle. Note that the DeArmond tool, the primary reference, shows a loop hanger 80 located near but not at the very end of the tool. The DeArmond tool is therefor a duplicative teaching of a tool having a loop hanger.

Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeArmand in view of Weisgerber as above applied and further in view of Pace et al.

Pace et al teaches that a tool may be made of composite materials. Note that the body 1 of the Pace tool is made from "4140 steel". 4140 steel is a chromium, molybdenum, manganese low allow steel and is therefore a composite material. 4140 steel is know for its toughness, good torsional strength, and good fatigue strength.

To make the above applied tool of DeArmand in view of Weisgerber from a composite material (like 4140 steel) would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Pace et al. One of ordinary skill in the art would have been motivated to do this in order to provide a strong and durable tool structure.

(10) Response to Argument

Applicant's principle arguments are: (1) In Weisgerber the web does not engage the arcuate portion of the support. (2) The addition of the Gottlieb reference to show a loop hanger appears superfluous in view of hole 80 (presumably hole 80 in DeArmond). (3) In Pace only the handle and not the tool is a composite material. (4) The Weisgerber web is not as large as applicant's web.

Applicant's argument that the Weisgerber web does not engage the arcuate portion of the support does not in any way negate the above rejection of DeArmond in view of Weisgerber. The Wiesgerber reference was not cited to show that a support may be arcuate because the primary reference DeArmond already shows an arcuate

support. Weisgerber was cited merely to set forth the broad teaching that a web may obviously span a body and a support for the purpose of increasing the strength of the device. DeArmond shows a body 30 and a support 70. To place a web between these elements in DeArmond is obvious because this is exactly what is taught by Weisgerber. The motivation for doing this, of course, is to increase the strength of the device.

Applicant argues that the addition of the Gottlieb reference to show a loop hanger appears "superfluous" in view of hole 80 (presumably hole 80 in DeArmond). Firstly, and most importantly, this statement by applicant is found to be an affirmation by applicant that hole 80 in DeArmond is, in fact, a loop hanger. Secondly, the examiner does not regard the Gottlieb reference to be "superfluous". The Gottlieb reference shows a loop hanger on the very end of the tool, the same location where applicant's loop hanger is located. The DeArmond loop hanger is not located at the very end of the tool but is rather located inward of a cushioning cap at the very end of the tool. The examiner therefor finds the Gottlieb teaching of a loop hanger on a tool to be duplicative rather than "superfluous" with respect to DeArmond's loop hanger.

Applicant argues that "only the grip for the handle and not the tool" of the Pace et al hammer is made of a composite material. Applicant further states that "applicant finds no support for the suggestion that the Pace reference discloses a composite tool". A careful reading of the Pace reference sets forth the fact that the Pace tool is made from 4140 steel. Perhaps applicant's argument is that 4140 steel is not a composite material. If this is applicant's argument then applicant is in error in reaching this

conclusion. It is well settled that 4140 steel is a chromium, molybdenum, manganese low allow steel and is therefore a composite material.

Applicant apparently takes that position that applicant's reinforcing web is larger than Weisgerber's reinforcing web and that this is an unobvious difference. It is respectfully submitted that applicant is in error in this position. Size considerations are ordinarily of no patentable significance. The following authority evidences this: **In Re Rose 105 USPQ 237 (CCPA 1955), "It has long been held that a change in size is not ordinarily a matter of invention".**

As a final thought, it is the examiner's position that applicant should not be granted a patent for merely adding a reinforcing strut to an existing tool such as the DeArmond tool. Will applicant next add a reinforcing strut to each of the Pace and Gottlieb et al tools, file patent applications with six line claims to those tools, and expect to be issued patents for those applications also? Applicant could do this for every tool that is currently patented. Conceivably, if this methodology were successful, applicant could become the patentee with the largest number of patents ever. However, this methodology would not be successful because long standing court decisions have already, once and for all, settled this issue. The courts consistently have held that the use of reinforcement by means of a "stiffening beam or rib" is a well known and obvious mechanical expedient. The following authority evidences this: **Peters v. Hanson, 1889 C.D. 44, "to make a part stronger for its proposed duty is not a patentable invention".**

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Robert C Watson

Robert C. Watson

Primary Examiner

Conferees:

Joseph J. Hail, SPE

Allan N. Shoap, SPE